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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,255	09/26/2003	Ki-Yeol Kim	SAM-0438CIP	8835

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EXAMINER

LE, UYEN CHAU N

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/672,255

**Applicant(s)**

KIM, KI-YEOL

**Examiner**

Uyen-Chau N. Le

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>40504 and 43004</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. The abstract of the disclosure is objected to because the abstract should be less than 150 words. Correction is required. See MPEP § 608.01(b).
3. The abstract of the disclosure is objected to because of its minor informalities.  
Re abstract, line 18: Delete "J:\SAM\0438cip\438CIPpatapp2.doc".  
Correction is required. See MPEP § 608.01(b).

### *Provisional Obviousness-Type Double Patenting*

4. Claims 1-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 16 of copending Application No. 10/465,062 (hereinafter '062).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1-19 of the instant application, Applicants claim a device for **generating a clock signal and decoding data**; for use in a **contactless** integrated circuit device comprising: "a receiver for receiving a **radio frequency (RF)** signal having a **pause period**"; "a divider for dividing the received RF signal to provide a **divided signal**"; "a **first counter** for

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counting a period of the divided signal at each **non- pause period** of the received RF signal”; “a second **counter** for counting a period of the divided signal”; “and a **decoder** for **generating a synchronous clock signal and a decoded data signal** in response to outputs of the first and second counters”; ... The ‘062 application discloses in claims 1-14 and 16 a device for **generating a clock signal and decoding data** for use in a **contactless** integrated circuit device comprising: “a receiver for receiving a **radio frequency (RF)** signal having a **pause period**”; a **divider** for dividing the received RF signal to provide a **divided signal**”; “a **first counter** for counting a period of the divided signal at each **non-pause period** of the received RF signal”; “a **second counter** for counting a period of the divided signal”; “and a **decoder** for **generating a synchronous clock signal and a decoded data signal** in response to outputs of the first and second counters, wherein the second counter is reset by the synchronous clock signal”; ... Although the scope of claims 1-19 of the present application and claims 1-14 and 16 of ‘062 application are almost identical, the difference between the present claimed invention and the ‘062 application is that the present claimed invention is a broader recitation of the ‘062 application (e.g., the present claimed invention recites “a **decoder** for **generating a synchronous clock signal and a decoded data signal** in response to outputs of the first and second counters, etc.” whereby the ‘062 application recites “a **decoder** for **generating a synchronous clock signal and a decoded data signal** in response to outputs of the first and second counters, wherein the **second counter is reset** by the synchronous clock signal, etc.”). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-14 and 16 of ‘062 application as a general teaching for having a device for **generating a clock signal and**

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**decoding data** for use in a **contactless** integrated circuit device with the same functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Suzuki (US 4377804 A); Kawai et al. (US 4729024 A); Arai (US 4897723 A); Asami (US 6036100 A); Ookawa et al. (US 6585166 B1) are cited as of interest and illustrate to a similar structure of a circuit for generating clock signal and decoding signal for use in contactless integrated circuit card.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon, Wed. and Fri. 5:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*Uyen-Chau N. Le*

September 19, 2004